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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT PAPER NUMBER

3629

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,695

Applicant(s)

HEUSINKVELD, RIGBY JACOBS

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 07012003, 03012002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. Claim 1 is objected to because of the following informalities: For claim 1, the phrase "an device" should be changed to "a device". "An device" is not grammatically correct. Appropriate correction is required.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 1, taking into account that the claim is an article claim, it is not clear to the examiner if the "use data" is being positively claimed or not. The use data is claimed as being obtained after installation. It is not clear if the use data is present on the device or not as claimed because this depends on whether the device has been installed yet. Also not clear is whether or not the use data is claimed as part of the consumable.

For claim 9, with respect to the limitation of "completing warranty requirements...", what does this mean? Nothing has been previously claimed about warranty requirements (not defined in any manner) so it is not clear what has to be done to be considered "completing warranty requirements". This limitation renders the claim indefinite.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirst et al. (5930553) in view of Siegel et al. (2003/0069750).

For claim 1,2,5-9,12,17-19,21, Hirst discloses that in the technology of image forming equipment (and specifically with respect to the consumables used in the equipment) it is difficult for manufacturers to obtain use data and other data of interest directly from the consumer. Manufacturers try to get customers to fill out and mail back survey cards that identify who they are and provide other useful data to the manufacturer but participation rates are very low. The gathering of data and being able to contact the buyer of the product directly is very important to the manufacturers. If the manufacturer cannot contact the buyer directly, they then cannot contact the buyer for recall notices, product sales, warranty information, etc. See the Background of the Invention section where this is discussed in more detail. Hirst also discloses that it is desirable for the manufacturer to be able to have software upgrades available in the memory of the consumable for uploading to the host device. This allows bugs and problems known to the manufacturer to be able to be fixed easily and effortlessly. Hirst also discloses in column 6, that an Internet connection may be used for the transfer of data and for software downloads.

Hirst discloses a consumable such as a toner cartridge that has a memory 19 included in the consumable for the storage of data and for the transfer of computer code from the consumable to the printer (or host device 10). The consumable and host device are interfaced together. The stored data may be one of a number of various

types of data that is of interest to a manufacturer. It is disclosed that warranty information is one type of data that may be stored in the memory of the consumable as well as use data (use related information). See column 3, lines 16-33. Hirst discloses assembling warranty fulfillment information because the use data is used in determining whether or not a consumable is under warranty or not for one reason or another and can be considered warranty fulfillment information. Hirst discloses the claimed invention except for the step of executing warranty software stored in the memory of the consumable and prompting a user for warranty relevant data.

Siegel et al. discloses that warranty cards are often not filled out by the consumer and manufacturers are deprived of useful data, sales promotion abilities, etc.. Siegel recognizes the same problem Hirst discloses with respect the filling out of survey cards, etc.. Siegel discloses that one solution for this problem in the area of software (or computer products) is that upon installation on a computer the user is immediately prompted for some various information that is sent over the Internet to a manufacturer and this results in the product being registered. The solution to the problem of low participation rates of returning registration cards/warranty cards is to have an automated registration process. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the consumable of Hirst with software that automatically prompts the user for some information (such as a name) upon installation of the consumable to register the product and buyer, with the information being sent to the manufacturer over the Internet.

With respect to claim 10, not disclosed is the use of a display for the prompting of the user. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the display of the computer (that the printer is hooked up to, that uses the consumable) prompt the user. The computer display is a very obvious way to prompt the user for information.

For claims 3,11,15,20, Hirst does not disclose what is claimed. It is considered obvious to one of ordinary skill in the art at the time the invention was made to print the warranty information for the buyer or save the information in an external device so that the buyer has a written record/backup copy of the warranty and registration of the product. Hard copies and backup copies of important documents (such as a warranty) saved on computers are especially important in the event the computer hard drive fails and the electronic information of the warranty is lost.

For claim 13, Hirst discloses that calibration data can be on the consumable that can be used to calibrate the device. Calibration is the same as running a diagnostic test, it is checking the device and resetting some value or variable if not correct.

For claim 14, Hirst does not disclose what is claimed. It is considered obvious to one of ordinary skill in the art at the time the invention was made to compare diagnostic information (calibration data) with warranty data in the event the buyer attempts to return the product. If the calibration data indicates that the consumable is calibrated correctly the manufacturer may not honor a replacement (covered under a warranty) when the alleged problem is improper calibration.

For claim 16, it necessarily follows from the teachings of Hirst that upon the installation of a new consumable, the new consumable will operate as did the original one in the sense that it will store use related data in the memory of the new consumable. This data may then be used in warranty inquiries (is warranty relevant data).

For claim 4, Hirst does not disclose that the consumable has a processor as claimed. Hirst does disclose that the printer that uses the consumable has numerous microcomputers (processors) that execute specific tasks with respect to the memory of the consumable. Hirst also discloses that the host device itself (i.e. printer driver) may execute tasks related to the memory of the consumable. Hirst recognizes that the processor that runs the steps of acquiring and storing information can be part of the printer or the host computer. All that is important is that there is a processor available to run the program that collects and saves data, as well as running the automated registration process as discussed for claims 1 and 9. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the consumable with a processor that can execute some or all of the tasks related to the memory of the consumable and the data it stores. A processor is already in the prior art and applicant is simply reciting a different location for the processor, which does not serve to patentably distinguish over the applied prior art.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Suliman Jr. et al. (2001/0053980), Pederson et al.

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(2002/0133425), Flickinger et al. (2001/0025245), Thomson et al. (2003/0061104), and Christensen et al. (5682140) disclose warranty types of systems or relate to consumables for image forming devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER